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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/885,755	06/19/2001	Brian Harms	QCPA567	6799
23696	7590	01/05/2004	EXAMINER	
Qualcomm Incorporated Patents Department 5775 Morehouse Drive San Diego, CA 92121-1714			WILLIAMS, LAWRENCE B	
			ART UNIT	PAPER NUMBER
			2634	

DATE MAILED: 01/05/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/885,755

Applicant(s)

HARMS ET AL.

Examiner

Lawrence B Williams

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-57 is/are pending in the application.
- 4a) Of the above claim(s) 54-57 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35,36,38-42,44-46 and 48-53 is/are rejected.
- 7) ☒ Claim(s) 37,43 and 47 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 May 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 54-57 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The original application claims subject matter relating to the "narrowing of frequency uncertainty of a detected pilot signal." Claims 54-57 are directed to "estimating a chip rate" which is distinct from the invention originally claimed.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 54-57 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 35 is rejected under the judicially created doctrine of double patenting over claims 1, 2 of U. S. Patent No. 6,249,539 B1 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

4. The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: The claim of the present invention is merely directed to an apparatus and coupling thereof comprising the means previously disclosed in the claims 1, 2 of prior U.S. Patent 6,249,539 B1.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

5. With regard to claim 36, claim 36 inherits all limitations of claim 35 above. Furthermore claims 3-4 of U.S. Patent No. 6,249,539 B1 fully encompasses the limitation disclosed in claim 36 of the present application.

6. With regard to claim 38, claim 38 inherits all limitations of claim 35 above. Furthermore, the subject matter disclosed in claims 12 and 13 of U.S. Patent No. 6,249,539 B1 fully encompasses the additional subject matter disclosed in claim 38 of the present application. Since pilot signals as well as user data are spread with a PN code prior to transmission in a spread

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spectrum system, it would be obvious to one skilled in the art that the despreading of the pilot signals using the PN code sequences would have to take place before the step of accumulating the signals.

7. With regard to claim 39, claim 39 inherits all limitations of claim 38. Furthermore, claims 5, 12, 16, and 17 of U.S. Patent No. 6,249,539 B1 fully encompass the subject matter disclosed in claim 39 of the present application.

8. With regard to claim 40, claim 40 inherits all limitations of claim 35. Furthermore claims 7, and 18 of U.S. Patent No. 6,249,539 B1 encompass the additional limitations of the claim.

9. With regard to claim 41, claim 41 inherits all limitations of claim 35. Furthermore claims 7, and 18 of U.S. Patent No. 6,249,539 B1 also encompass the additional limitations of the claim.

10. With regard to claim 42, claim 42 inherits the limitations of claim 35. Furthermore, claim 3 discloses the pilot signal as a spread spectrum signal.

11. With regard to claim 44, claim 44 inherits the limitations of claims 38 and 42 above.

12. With regard to claim 45, claim 45 inherits the limitations of claims 39 and 44 above.

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13. With regard to claim 46, claim 46 inherits all limitations of claim 44 above. Furthermore, the subject matter disclosed in claims 16 and 17 of U.S. Patent No. 6,249,539 B1 encompass the additional limitations of the claim.

14. With regard to claim 48, claim 48 inherits the limitations of claims 40 and 42 above.

15. With regard to claim 49, claim 49 inherits all limitations of claims 41 and 48.

16. With regard to claim 50, claim 50 inherits all limitations of claim 49 above. Furthermore, the subject matter disclosed in claim 2 of U.S. Patent No. 6,249,539 B1 encompasses the limitations of the claim.

17. With regard to claim 51, claim 51 inherits all limitations of claim 42 above. Furthermore, the subject matter disclosed in claim 2 of U.S. Patent No. 6,249,539 B1 encompasses the limitations of the claim.

18. With regard to claim 52, claim 52 inherits all limitations of claim 42 above. Furthermore, the subject matter disclosed in claim 2 of U.S. Patent No. 6,249,539 B1 encompasses the limitations of the claim. It is obvious to one skilled in the art that this process should occur during demodulation and would therefore be obvious of its inclusion in a digital data receiver to one of ordinary skill in the art.

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19. With regard to claim 53, claim 52 inherits all limitations of claim 42 above. Furthermore, the subject matter disclosed in claim 10 of U.S. Patent No. 6,249,539 B1 encompasses the limitations of the claim. It would be obvious to one skilled in the art to choose a satisfactory sample rate for the system.

Conclusion

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence B Williams whose telephone number is 703-305-6969. The examiner can normally be reached on Monday-Friday (8:00-5:00).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Chin can be reached on 703-305-4714. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4750.

Lawrence B. Williams

lbw

December 19, 2003


STEPHEN CHIN
SUPERVISORY PATENT EXAMINE
TECHNOLOGY CENTER 2800